

Remarks

I. Introduction

This is in response to the Final Office Action dated December 8, 2009, and is filed within two months from the mailing date of the Final Office Action in accordance with the Expedited Procedure set forth in MPEP §714.13 (V).

The Office Action rejected claims 1-9, 11, 12, 14-22, and 26-28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,649,001 to Thomas et al. ("Thomas") in view of U.S. Publication No. 2001/0037491 to Boggs et al. ("Boggs"), further in view of U.S. Patent No. 6,307,880 to Evans et al. ("Evans"). Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Boggs further in view of Cisco Systems. Claims 13 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Boggs further in view of U.S. Patent No. 6,978,319 to Rostoker et al. ("Rostoker"). Claims 23-25 and 30-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Boggs further in view of U.S. Publication No. 2003/0167391 to Al-Ali ("Al-Ali").

In response, claims 1, 2, 9, 14, and 26 have been amended. Claims 1-32 remain for consideration.

II. Request for Amendment after Final to be Entered

This amendment is being submitted as a reply under §37 C.F.R. 1.116 as suggested by Examiner Hassan during the interview of January 26, 2010 described below. Under 37 C.F.R. 1.116(b)(3), "[a]n amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented." Applicants submit that the amendments herein are necessary to overcome the cited references and were not presented earlier since the Examiner's specific reasoning supporting the rejections was not clear until

the Final Office Action mailed December 8, 2009 was received by Applicants and clarified by discussion during the Examiner Interview of January 26, 2010 during which Examiner Hassan suggested filing this Reply under 37 C.F.R. §1.116. In addition, the amendments present the rejected claims in better form for consideration on appeal. For at least the reasons above, Applicants request that this amendment be entered.

III. Interview Summary

A telephonic interview between Applicants representative, Joseph G. Fenske, Reg. No. 54,592, and Examiner Aurangzeb Hassan was conducted on January 26, 2010. During the interview the rejections of claims 1, 2, 9, 14, and 26 under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Boggs further in view of Evans were discussed. The Examiner indicated that the claims as amended herein overcome the cited references and suggested filing a reply under 37 C.F.R. §1.116.

IV. Rejections under 35 U.S.C. §103

In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the cited references, either alone or in combination, teach all of the claim limitations of currently amended independent claims 1, 2, 9, 14, and 26. Therefore, Applicants request the withdrawal of the rejection of independent claims 1, 2, 9, 14, and 26 under 35 U.S.C. §103(a).

The subject area of the present invention relates generally to a device, system, and method for the automatic configuration of a network communication device. In one embodiment a programmable cable is adapted to configure a network communications device. The programmable cable has one end

connectable to a PLC and another end connectable to the network communications device.

In one embodiment described in paragraph [0017], "the network communications device can comprise a subscriber identity module ("SIM"). The SIM can be a memory device that stores information comprising a subscriber's identification information and networks where the subscriber is entitled to service. The SIM can require a PIN to activate service...In certain embodiments, the network communications device 1300 can be inoperable without the SIM...The existence of a SIM that requires a PIN to operate can discourage unauthorized use or theft of the SIM and/or the network communications device 1300." Paragraph [0016] states that "in an exemplary embodiment, the PIN number can be supplied by the programmable cable 1100 to the network communications device 1300 to allow operation of network communications device 1300."

This aspect of a network communications device comprising a SIM, storing a PIN number associated with the SIM in the programmable cable, and supplying the PIN to the communications device in order to activate service and enable the network communication device is claimed in currently amended independent claim 2. Currently amended independent claim 2 includes the limitations of "a cellular telephone modem comprising a subscriber identity module (SIM)... said programmable cable adapted to store a plurality of configuration parameters and a PIN number associated with the SIM... said programmable cable adapted to automatically configure said cellular telephone modem by communicating at least one of the configuration parameters and the PIN number to said cellular telephone modem to activate service and enable the cellular telephone modem to function."

Thomas, Boggs, and Evans, separately or in combination, do not disclose these limitations. The Office Action admits that Thomas and Boggs do not teach a PIN number associated with enabling a network communications device to

function. The Office Action states that Evans "teaches a PIN number utilized in the identification of a cellular device that allows for enabling the cellular telephone modem." Although Evans discloses a PIN number, the PIN number of Evans is not described as associated with a SIM or a SIM that requires a PIN to activate service.

Evans is directed to a method and apparatus for automatically switching between voice and data communications as directed by a voice and data capable modem via a cable assembly incorporating a switching means for facilitating and inhibiting the routing of voice information to a voice telephone. A voice and data capable modem incorporates the software functionality associated with a voice and data capable protocol with minimal impact to the form factor associated with the modem. To reduce the impact to the form factor associated with integrated modem designs, the switching hardware associated with voice and data capability is incorporated into a cable assembly used to interconnect the voice and data capable modem with the voice telephone. Additional means for identifying the cable assembly as having the requisite switching functionality is also provided.

In one embodiment of Evans, the means for identifying the cable assembly is cable identifier 92. Column 9, lines 13 – 17 state that "in FIG. 3 the cable identifier means is depicted as cable identifier 92... cable identifier 92 comprises a non volatile memory device, such as a read only memory (ROM) capable of being queried by the modem."

Cable ID 92 of Evans is associated with Evans cable 66 and not with a SIM. Further, no section of Evans discloses the use of a SIM or a SIM that requires a PIN to activate service. Thus, Evans does not disclose "a network communications device comprising a subscriber identity module (SIM)" or "a PIN number associated with the SIM...to activate service" as recited in independent

claim 2. As such, Thomas, Boggs, and Evans, separately or in combination, fail to disclose each and every limitation of independent claim 2. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 2 under 35 U.S.C. §103(a).

Independent claims 1, 9, 14, and 26 each contain limitations similar to the limitation discussed above in connection with independent claim 2. Therefore, the cited references, either alone or in combination, do not disclose each and every limitation of independent claims 1, 9, 14, and 26 for the same reasons discussed above in connection with independent claim 2. As such, the cited references cannot render independent claims 1, 2, 9, 14, and 26 unpatentable under 35 U.S.C. §103(a). Accordingly, Applicants respectfully request withdrawal of the rejections of independent claims 1, 2, 9, 14, and 26 under 35 U.S.C. §103(a).

For the reasons discussed above, independent claims 1, 2, 9, 14, and 26 are allowable over the cited art. All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable.

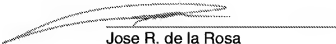
V. No New Matter has Been Added

The amendments to claims 1, 2, 9, 14, and 26 do not add new matter. Support for the amendments can be found at least in paragraphs [0016] and [0017] of the specification as originally filed.

VI. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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